

## REMARKS

The Final Office Action of July 10, 2008 rejected each of the pending claims under 35 U.S.C. §103 as being obvious over Deem, U.S. Patent No. 6,558,400 in view of Schurr et al., U.S. Patent Publication No. 2002/0082621. Because a *prima facie* case of obviousness was not established in the Office Action, Applicant submits this Rule 116 Amendment demonstrating that the application is properly placed in condition for allowance.

### **Claim 1**

Claim 1 calls for a gastroplasty device that includes *inter alia* first and second tissue adhering acquisition members, and "at least one of the acquisition members is movable relative to the first longitudinal axis between a delivery configuration and a deployment configuration." The Office Action concedes that Deem fails to disclose this feature of the claimed invention. [O.A., p.3]. In an attempt to overcome this shortcoming, the Office Action relies on the disclosure of Schurr to show that it was known in the art to have a pivoting tissue acquisition member. The Office Action then concludes that "it would have been obvious ... to provide a pivotable tissue acquisition member, as taught by Schurr, to Deem since it was known in the art that pivotable tissue acquisition members facilitate grasping and apposition of tissue to ensure a secure engagement of the tissue(s)." [O.A., p. 3]. However, the benefits of Schurr and Deem are not compatible, and the modification of one would destroy the other, rendering the proposed modification non-intuitive and contrary to the teachings of each.

### **Deem**

The portion of the Deem disclosure referenced by the Office Action correspond to Figures 9 – 11 [O.A., p. 3], which are directed to a stapling device. Stapling devices 176 and 192 have rigid staples inside, and therefore each tissue acquisition member has to be fixed. If the acquisition member was movable relative to the first longitudinal axis the staples would be deformed, eliminating any useful application of the stapling device. Moreover, the stapling devices of Deem use vacuum ports 178, 194 to acquire tissue in

an opposed position. Thus, no movement is necessary for the stapling device to adhere the tissue.

### Schurr

Schurr discloses a drawbridge type clamping mechanism that includes a telescoping arm to push tissue against an overtube. The telescoping arm extends radially from an axis **transverse** to the longitudinal axis of Claim 1. With no vacuum ports, Schurr relies on the drawbridge mechanism to capture tissue.

### The Rejection Of Claim 1

The Office Action states that "the combined teachings of Deem and Schurr suggest to those of ordinary skill in the art that having a pivotable tissue acquisition members (sic) would further facilitate grasping and apposition of tissue to ensure a secure engagement of the tissue(s)." However, the Office Action does not explain how the Deem stapling device could be modified and still operate as a stapling device. Because staples are loaded in the compartment, neither tissue acquisition members can pivot or move since the staples would prevent such movement. Moreover, having either tissue acquisition member telescope or move outward would reduce the effectiveness of the vacuum ports, which rely on close quarters to capture the tissue. If the ends of the stapling device telescoped outward as taught by Schurr, tissue would be move away from the vacuum ports of Deem and prevent the device from capturing the tissue. Applicants submit that one skilled in the art, presented with the teachings of Deem and Schurr, would recognize the two teachings as more exclusive and alternatives than complimentary teachings capable of combining.

To utilize the teachings of both as proposed by the Office Action renders each device *less* effective and, therefore, one of ordinary skill would not have been compelled to combine the teachings as proposed by the Office Action. **MPEP §2143.02** ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious"). Here, Deem's stapler would not appear to operate as a stapler if combined with Schurr as proposed by the Office Action, and therefore the combination is improper and Claim 1 is patentable.

### **Claim 7**

Claim 7 includes the feature of a gastroplasty device that includes a tissue acquisition member movable relative to the longitudinal axis between a delivery configuration and a deployment configuration. The Office Action acknowledges that Deem fails to teach this feature. [O.A., p. 3]. However, the Office Action contends that the drawbridge mechanism of Schurr would compel one of ordinary skill in the art to modify Deem to include a pivotable acquisition member. However, as stated above, Deem uses vacuum ports rather than a trapping arm to capture tissue, so the mechanism of Schurr would be of little use in connection with the Deem device. Moreover, by extending the arm radially outward, the opportunity to capture tissue using the vacuum ports is diminished, rendering the operation and benefits of the Deem device in doubt. Further, the presence of staples in the Deem device prevents relative motion about the longitudinal axis since such motion would deform or break the staples. Accordingly, the proposed combination would not have been obvious to one of ordinary skill in the art, and in fact would be likely dismissed by said ordinary artesian as counterproductive and contrary to the teachings of the individual references. As such, Applicants respectfully submit that Claim 7 is patentable over the Deem/Schurr proposed combination and is properly allowed.

### **Claim 21**

Claim 21 is directed to a gastroplasty device that includes a vacuum chamber that "is pivotable relative to the longitudinal axis between a delivery configuration and a deployment configuration." The Office Action never identifies where in Deem the vacuum chamber (separate from the already recited "inner volume"), and Figures 9A-11B cited by the Office Action offer no illumination. Moreover, Claim 21 calls for the vacuum chamber to pivot relative to the longitudinal axis. The Office Action concedes that Deem fails to teach this feature, but nowhere is there any teaching in Schurr of a vacuum chamber (or any structure for that matter) that pivots relative to the longitudinal axis. Because this feature is not discussed in the Office Action, the Final Office Action was improper because Applicant has no understanding of why the claim was refused. Moreover, as explained above, the Deem device cited by the Office Action is a stapling

device that carries staples arranged in a longitudinal fashion. If the purported tissue acquisition member of Deem were somehow modified to pivot about the longitudinal axis, it would appear to diminish or incapacitate the device's ability to function as a stapler. Such a modification is expressly deemed to **not** demonstrate a *prima facie* case of obviousness in the MPEP. See § 2143. Accordingly, the rejection of Claim 21 is improper and Applicant respectfully submits that the Claim is in condition for allowance.

Applicant has demonstrated that each and every rejection set forth in the Office Action is properly withdrawn, placing the application in condition for allowance. Claims 1, 3-11 and 13-28 remain pending in the application and reconsideration is respectfully requested. The undersigned can be reached at (310) 824-5555 to facilitate prosecution of the application.

The Commissioner is authorized to charge any deficiencies or fees in connection with this amendment to Deposit Account No. 06-2425.

Respectfully submitted,

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